

**REMARKS**

Applicants initially thank the Examiner and his Supervisor for their courtesy to extend a telephonic interview with the undersigned Applicant's representative on July 29, 2008. During the interview, Applicants proposed a claim amendment for better clarify of the claim language. The Examiner also suggested amending claim 1 to make clear that the template indicates that files from different print jobs are to be merged. Claim 1 has been amended accordingly.

For the reasons presented in at the interview and further discussed below, this application is allowable. Applicants respectfully request the Examiner, in the event the Applicant's arguments are not found to be persuasive, to contact the undersigned before issuing an Office Action.

Claims 1-3, 5, 7-12 and 15 have been amended, primarily to place the claims in better for examination in accordance with U.S. patent practice. No new matter has been presented.

Claims 1, 7, 8, 14 and 15 are rejected under 35 USC 102(b) as being anticipated by Hamilton, U.S. Patent No. 5,715,381. This rejection is respectfully traversed.

Claim 1 recites "a template determination section configured to determine, upon reception of a first job including a first file to be printed, whether or not *the first job includes a template* which indicates that a plurality of files including the first file and a second file are to be merged, wherein the *second file is included in a second job*" (emphasis added). This feature is not taught or suggested by Hamilton.

Hamilton discloses a printing system in which print jobs are associated with a package and, upon printing the package, each print job in the package is printed in accordance with print instructions included in the respective print job and the properties specified in the package. See Hamilton, Col. 4, lines 1-8 and Col. 10, lines 20-25. The package, in addition to references to print jobs, includes properties that apply to the package as a whole for printing the print jobs. Hamilton, Col. 10, lines 20-25. Such properties include, for example, a first page label override, which overrides the first page labeling of the documents in the print jobs, and an embedded document first

page merge item, which overrides a merge item (rather than a label) on the first page of the documents in the print jobs. See Hamilton, Col. 10, line 25 to Col. 11, line 26. Using the package, Hamilton allows the plurality of jobs to be printed together as one package.

Unlike the claimed invention, in which the job includes a template which indicates whether a plurality of files are to be merged, in Hamilton, it is the package itself, and not the print job, that identifies the files to be merged so that the files are printed together as a part of the package. Hamilton does not teach merging a document from a first package with a document from a second package. In contrast, claim 1, as amended, recites “a *first job including a first file*” and “a template which indicates that a plurality of files including the *first file and a second file* are to be merged, wherein the *second file is included in a second job*” (emphasis added). Thus, Hamilton’s package does not correspond to the claimed first job. Accordingly, Hamilton fails to anticipate claim 1.

During the interview, the Examiner indicated that Hamilton’s disclosure of “embedded document first page merge item” corresponds to the claimed template. Applicants respectfully disagree. As stated above, in Hamilton, the package, and not the print job, identifies the files to be merged so that the files are printed together as a part of the package. Hamilton’s “embedded document first page merge item” is a part of the package, not the print jobs. There is no teaching or suggestion in Hamilton that a job includes any type of template or merger instruction which indicates that a print file in that job is to be merged with another file from a different job. In fact, in Hamilton, if the jobs themselves included instructions or templates indicating that they are to be merged, there would no longer be a reason to use a package. Thus, Hamilton fails to anticipate claim 1.

The Examiner also indicated during the interview that even if Hamilton’s jobs do not include the claimed template, it would have been obvious to modify Hamilton so that the jobs include instructions regarding whether they are to be merged. Applicants once again respectfully disagree. One of ordinary skill in the art would have had no reason or motivation to modify Hamilton to

include the claimed template in the print jobs. Specifically, if Hamilton's print jobs were to be modified to include the claimed template or any other merger instructions, there would no longer be a reason to use Hamilton's package. Thus, such modification would go against Hamilton's principle of operation. Thus, Hamilton fails to render claim 1 obvious.

Accordingly, claim 1 is allowable. Claims 8 and 15 include similar features as claim 1 and are similarly allowable. Claims 7 and 14 depend from claims 1 and 8, respectively, and are similarly allowable.

Claims 2-4 and 9-11 are rejected under 35 USC 103(a) as being unpatentable over Hamilton in view of Dimperio, U.S. Patent No. 6,965,445. Claims 5 and 12 are rejected as being unpatentable over Hamilton in view of known prior art. These rejections are respectfully traversed.


Claims 2-4 and 9-11 depend from claims 1 or 7, and are allowable over Hamilton for at least the same reasons. Neither Dimperio, nor known prior art, overcome the deficiencies of Hamilton in teaching the features of claims 1 and 7. Thus, claims 2-4 and 9-11 are allowable.

In view of the above, each of the claims in this application is in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. **204552032100**.

Dated: August 5, 2008

Respectfully submitted,

By   
Amir Rohani

Registration No.: 61,782  
MORRISON & FOERSTER LLP  
1650 Tysons Blvd, Suite 400  
McLean, Virginia 22102  
(703) 760-7757